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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91202562 |
| Party | Defendant<br>Velocity, LLC |
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| Signature | /Andrea J Mealey/ |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Boston Athletic Association,<br><br>Opposer,<br><br>v.<br><br>Velocity, LLC<br><br>Applicant. | Opposition No.: 91202562<br>Application Ser. No.: 85/224698<br>Mark: MARATHON MONDAY<br>Class: 25 |

**APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION**

I. Introduction

Opposer , Boston Athletic Association's ("Opposer") Motion for Leave to File Amended Notice of Opposition (the, "Motion") to revise its Notice in part and to add a new grounds of descriptiveness should be denied, and applicant, Velocity, LLC ("Applicant") hereby opposes such Motion.

The Motion is being brought too late. Opposer makes no explanation as to why it did not draft the Notice of Opposition accurately when it was originally filed nor does Opposer explain why it did not assert the alleged descriptiveness grounds in its original Notice of Opposition. Further, Opposer does not indicate why it waited for ten months to amend its pleading. The Motion should be denied solely on this basis. However, the Motion should also be denied because neither the clarification nor the newly pled ground are based on any new or previously unavailable materials. Opposer's Motion is merely meant to cause unnecessary delay and costs and wastes the limited resources of the

Trademark Trial and Appeals Board (the "Board") and as such should be denied and this behavior not condoned by the Board.

II. The Motion is Filed Too Late

The timing of a motion for leave to amend is a major factor in determining if such amendment will prejudice the non-moving party. *See* TBMP § 507.02 and cases cited therein. Opposer learned of Applicant's application when it was published on July 19, 2011. Opposer filed two Extensions of Time to Oppose the application and the Notice of Opposition was filed on November 16, 2011. Over thirteen (13) months have passed since Opposer first learned of Applicant's application and more than ten (10) months have passed between the filing date of the Notice of Opposition and the filing date of the Motion. Both parties are well into their investigation of the facts and the assessment of their respective claims and defenses and have conducted written discovery.

Opposer argues that this Motion is timely because discovery is still open. Discovery was scheduled to close the day after the filing date of the subject Motion. Additionally, Opposer has not offered any explanation at all for its delay in seeking leave to amend. *See* Minter v. Prime Equipment Co., 451 F.3d 1196, 1206 (10th Cir. 2006) ("denial of leave to amend is appropriate 'when the party filing the motion has no adequate explanation for the delay'").

To grant the subject Motion which is filed to correct for omissions or oversights known to the Opposer at the commencement of the case will force the parties to revisit the entire discovery process anew, and this unreasonably burdens and prejudices the Applicant.

II. The Motion is not based on Any New Information

Opposer asks to make two amendments – one to "clarify" facts and a second that Opposer couches in terms of a clarification, but which is actually a newly asserted basis for its opposition. It is established that a motion to amend should be filed as soon as any new ground for such amendment, such as newly discovered evidence, becomes available. *See* Media Online Inc. v. El Classificado, Inc., 88 U.S.P.Q.2d 1285 (TTAB 2008). In the instant case, the "clarification" and new grounds proposed by the Motion have been known to Opposer since the beginning of the case. There has been nothing newly learned or uncovered that requires granting Opposer leave to amend its Notice of Opposition. Further, Opposer has not offered any plausible explanation or reason why the amendments sought were not previously incorporated in its pleadings. Denial of leave to amend is appropriate in such circumstances. *See* Kaplan v. Rose, 49 F.3d 1362, 1370 (9th Cir. 1994) (Affirming District Court's denial of leave to amend when facts upon which proposed amendment was based, "were known to [plaintiff] from the beginning of the litigation").

The first point of "clarification" that the Opposer wants to make to Paragraph 10 of the Notice of Opposition is that Opposer "or its licensees" make clothing. It is not a new development that Opposer has licensees. Opposer has known since well before the filing date of the Notice that it has had licensees. Here, Opposer asks after ten months to amend its Notice of Opposition to include a fact about the Opposer's own business which fact well known to the Opposer well before and at all times since the time of the filing and which are not related to any new developments or information. Such amendment is not within the spirit of Rule 15(a).

The Opposer then states it has a second point of clarification requested in the proposed amended Notice of Opposition. This is not a mere point of clarification; rather, the Opposer is actually adding a new claim that the Applicant's mark is merely descriptive. Opposer states that it originally plead that Applicant's mark was merely descriptive, however, a review of the original Notice of Opposition does not contain such a pleading. Now, the Opposer is trying to shoe-horn this ground for opposition in as an amendment that is conveniently labeled a "point of clarification."

Further, Opposer attempts to cover its tracks that it is adding a previously unpleaded basis for opposition by claiming that it forgot to check off the boxes for its bases of its Notice of Opposition for "False Suggestion of an Association" as well as "descriptiveness." Applicant notes that the ESTTA cover sheet of record with the TTAB shows that Opposer checked the box for False Suggestion of a Connection, and notes that this was plead in the Notice of Opposition. Similarly, Opposer also remembered to check the box for Priority and Likelihood of Confusion, which was also plead in the Notice of Opposition. Opposer did not check the box stating that the grounds for opposition are that the mark is merely descriptive because such grounds were not pled in the Notice of Opposition.

Opposer also alleges that it was not until Opposer conducted discovery that it learned that Applicant allegedly did not have enough sales to assert that its mark had acquired distinctiveness. Opposer is incorrectly asserting that it could not plead descriptiveness as a grounds for opposition until it had information about whether Applicant had a winning defense. Opposer is therefore asking to amend its Notice of Opposition not because a new claim has arisen based on discovery, but because, in

Opposer's opinion, it does not believe the Applicant has a defense of acquired distinctiveness.

There is nothing in the Motion that explains why Opposer could not have asserted a claim that the mark is merely descriptive when the Notice was filed. In fact, Opposer's claim that it needed to learn how long Applicant had been using its mark through materials produced during Discovery is disingenuous – the Applicant's dates of use are clearly set out in the application record. The prosecution history is clear. Applicant filed its application on January 24, 2011 based on its intent to use the mark. Applicant then filed an Amendment to Allege Use on April 24, 2011, stating that use of the mark commenced on April 11, 2012. All of this information was available to the Opposer at the time that the application was published, well before the Notice of Opposition was filed. It is clear from the prosecution record which Opposer read in order to know that Applicant filed its application based on intent to use, that the Applicant has been using its mark since April 2011. The time needed to acquire distinctiveness under 15 U.S.C. § 1052(f) is five years. It is clear from the application that Applicant has not used its mark for five years or more.

The newly pled basis for opposition, namely that Applicant's mark is allegedly merely descriptive, is based on facts within Opposer's knowledge when the Notice of Opposition was filed. Under such circumstances, a motion for leave to amend should be denied. *See* Trek Bicycle Corporation v. StyleTrek Limited, 64 U.S.P.Q.2d 1540 (TTAB 2001) (denying motion for leave to amend filed before close of discovery but based on facts known to opposer prior to institution of the case).

IV. Conclusion

The Opposer's undue delay in seeking to clarify information about its own business and in seeking to add a claim available at the outset of the case which is not based on any new information will unfairly prejudice Applicant by increasing the time, effort and cost that Applicant must spend to defend this Opposition. Such attempt to treat this case in a piecemeal manner also wastes the limited resources of the Board.

For all o the foregoing reason, Applicant respectfully requests that the Opposer's Motion for Leave to File Amended Notice of Opposition be denied.

VELOCITY, LLC.

By its Attorneys,

/Andrea J. Mealey/

Date: October 8, 2012

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 8th day of October 2012, I served a true and accurate copy of the foregoing Applicant's Opposition to Opposer's Motion for Leave to File Amended Notice of Opposition to Opposer's counsel by first class mail addressed as follows:

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